Paper No. 21

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GILBERT H. HONG,

Junior Party,[1]

v.

GLENN E. STORM,

Senior Party.[2]

Patent Interference No. 103,636

Before URYNOWICZ, RONALD SMITH, and MARTIN, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

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[1] Patent 5,344,677, granted September 6, 1994, based on Application 07/936,758, filed August 27, 1992.

[2] Application 08/046,470, filed April 13, 1993.

FINAL DECISION

On September 24, 1996, the party Storm filed a preliminary motion under 37 CFR § 1.633(a) for judgment that the sole corresponding claim of the party Hong is unpatentable to Hong under 35 U.S.C. §§ 102(a) and 102(b) as being anticipated by Japanese Kokai No. 2-250,055 to Sugimoto (Paper No. 8). On October 9, 1996, the party Hong filed an opposition to the motion of Storm consisting of the sole argument that the motion should be denied because "Neither the translation nor the purported Kokai have been authenticated..." (Paper No. 11). In its reply, Storm indicated that it considers Hong's objection unfounded but, at the same time, filed a certified copy of the Japanese Kokai and a Verification of Translation. (Paper No. 13).

On February 7, 1997, the Administrative Patent Judge (APJ) issued a Decision on Preliminary Motions (Paper No. 15). In that decision Storm's motion for judgment under 37 CFR § 1.633(a) was granted (item I.) and a motion of Storm to redefine this proceeding was dismissed as moot (item II.). In item I., the APJ indicated that (1) Hong's objection to the motion was overcome by Storm's filing of a certified copy of

the Japanese Kokai and a verification of translation, (2) Storm's motion was unopposed on its merits and (3) the motion is granted based on the showing made in the motion. In the decision, Hong was ordered to show cause under 37 CFR § 1.640(d)(1) why judgment should not be entered against it because the decision on Storm's motion for judgment under 37 CFR § 1.633(a) was dispositive of the interference. Not having received a response to the order in the time set, the Board issued judgment against Hong on March 27, 1997.

A copy of the Decision on Preliminary Motions was not received by Hong. In a letter mailed April 16, 1997, the APJ acknowledged that Hong's copy had been returned to the Board undelivered. At that time, the judgment of March 27, 1997 was vacated, a copy of the Decision on Preliminary Motions was mailed to Hong and the junior party was given twenty days to respond to the order to show cause contained therein.

In response to the order, Hong filed a paper titled THE PARTY HONG'S RESPONSE TO ORDER TO SHOW CAUSE MAILED APRIL 16, 1997 (Paper No. 20), which paper falls within the

provisions of 37 CFR § 1.640(e)(1)(ii)[3]. In answer to Hong's response to the order, Storm filed a reply provided for under 37 CFR § 1.640(e)(2) (Paper No. 19). Whereas neither party requested a final hearing, the decision of the APJ that is the basis for the order to show cause is before us for review based on the contents of Hong's paper and Storm's reply. 37 CFR § 1.640(e)(4).

Positions of the Parties

Hong argues it was not appropriate for the APJ to

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[3] Rule 640(e)(1)(ii) reads as follows:

> (e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order.
>
> (1) If the order was issued under paragraph (d)(1) of this section, the paper may:
>
> (i) Request that final hearing be set to review any decision which is the basis for the order as well as any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at final hearing or
>
> (ii) Fully explain why judgment should not be entered.

simultaneously rule on its evidentiary objection to the Japanese Kokai and the merits of Storm's motion for judgment because Hong was not given an opportunity to address the merits after Storm's reply and after the Board's ruling on the objection. The junior party contends that the APJ should have decided the evidentiary objection alone and then should have provided the junior party an opportunity to oppose the merits of Storm's motion rather than rule on its merits simultaneously. Hong then argues in its response that Storm's motion for judgment is without merit and urges that judgment should not be entered against it.

Hong no longer asserts an evidentiary objection to the Japanese Kokai.

Storm contends that it was incumbent on Hong to provide a substantive response to Storm's motion for judgment when it filed its opposition to the motion. In support of its contention, the junior party draws attention to the fact that 37 CFR § 1.638(a) provides that an opposition shall (1) identify any material fact set forth in the motion which is in dispute and (2) include an argument why the relief requested in the motion should be denied. Storm asserts that Hong's opposition was silent in both respects and that it is too late for Hong to now make a showing on the merits of the senior party's motion.

Opinion

The question before us is whether an opponent can raise a new matter in a response filed under 37 CFR § 1.640(e)(1)(ii) to an order to show cause issued against it under 37 CFR § 1.640 (d)(1). In answering that question, we must decide whether the argument of an opponent provided for under 37 CFR § 1.638(a) should include all issues which the party is aware of at the time, and which it might later wish to argue under 37 CFR
§ 1.640(e)(1)(ii).

We are of the opinion that the junior party is not entitled to be heard on the merits of its argument relating to the Japanese Kokai which was first presented in its response to the order to show cause.

A party is not entitled to raise for consideration at final hearing any matter not raised by the party in a timely filed opposition to a motion under 37 CFR §§ 1.633 or 1.634. 37 CFR
§ 1.655(b). This decision is not a final decision under 37 CFR
§ 1.658. However, as a decision under 37 CFR § 1.640(e)(4), it involves an alternative procedure available to a party for review of matters properly raised under 37 CFR §§ 1.633 or 1.634. By analogy to Rule 655(b), Hong is not entitled to argue the merits of the finding of unpatentability over the Japanese Kokai at this time because it did not so argue in its opposition to Storm's motion.

The sole exception to the above provision of Rule 655(b) is when a party is able to show good cause why the issue was not properly raise by a timely filed opposition. We think that such an exception is available to a party in Hong's position. How-ever, the fact that Hong opposed Storm's motion for judgment on a procedural ground, its evidentiary objection, did not somehow excuse Hong from providing a complete opposition. In no way was Hong precluded from simultaneously arguing the merits of Storm's motion in its

opposition. That Hong might not prevail on its evidentiary objection was readily foreseeable and something which Hong should have guarded against.

Hong's failure to provide a complete opposition is contrary to the public interest in avoiding piecemeal prosecution of interferences, Pritchard v. Loughlin, 361 F.2d 483, 487, 149 USPQ 841, 844 (CCPA 1966), and to the spirit and scope of the new rules which have been implemented to provide "the just, speedy and inexpensive determination of every interference." 37 CFR § 1.601. To allow a junior party such as Hong to piecemeal its opposition is to allow a party the opportunity to control a proceeding and to open the door to harassment of one party by another by effectuating procedural delay. This would diminish the APJ's control over an interference, contrary to the provisions of 37 CFR § 1.610(c), and defeat the goal of achieving the just, speedy and inexpensive determination of interferences.

Whereas Hong's response to the order to show cause fails to show good cause why judgment should not be entered against it, because its arguments on the merits in its response are entitled to no consideration, judgment against Hong under 37

CFR § 1.640 (e)(4) is now proper.

Interference No. 103,636

Judgment

Judgment as to the subject matter of the count in issue is awarded to Glenn E. Storm, the senior party. On the present record, the party Storm is entitled to a patent with its claims 1-18 corresponding to the count. The party Hong is not entitled to its patent with its claim 3.

STANLEY M. URYNOWICZ, JR.)
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Interference No. 103,636

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